



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/837,446	04/17/2001	Eugene C. Butcher	STAN110CON	4334

24353 7590 04/08/2003

BOZICEVIC, FIELD & FRANCIS LLP
200 MIDDLEFIELD RD
SUITE 200
MENLO PARK, CA 94025

EXAMINER

ROARK, JESSICA H

ART UNIT	PAPER NUMBER
----------	--------------

1644

DATE MAILED: 04/08/2003

//

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/837,446

Applicant(s)

BUTCHER ET AL.

Examiner

Jessica H. Roark

Art Unit

1644

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 January 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 23-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 23-38 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Art Unit: 1644

DETAILED ACTION

1. Claims 23-38 are pending.

2. Applicant's election with traverse of the species of atopic dermatitis in Paper No. 9 is acknowledged. The traversal is on the grounds that the species overlap and one patient may have more than one disease. This is not found persuasive because although some overlap may sometimes be present, the patient populations are nevertheless recognized as distinct and a search for one condition is not co-extensive with a search for any others.

The Species Election is still deemed proper and is therefore made FINAL.

However, after further review it is noted that the claims as amended on 9/19/02 recite a "CCR4 antagonist" broadly, encompassing multiple products. The specification discloses on page 11 of the specification at line 16 to page 17 at line 19 that "CCR4 antagonist" encompasses a peptide, small organic molecule, peptidomimetic, soluble T cell receptor, antibody or the like. Each disclosed "CCR4 antagonist" has a *distinct structure*. These structurally distinct products are subject to restriction, rather than election of species, because they do not share a *substantial structural feature essential to a common utility* (as per MPEP 803.02)

Therefore, a supplemental restriction has been set forth below for each product that may be a "CCR4 antagonist" as a separate group, irrespective of the format of the claims.

Restriction Requirement

3. Restriction to one of the following inventions is required under 35 U.S.C. § 121:

I. Claims 23-38, drawn to a method of blocking trafficking of systemic memory T cells by administering a CCR4 antagonist that is an **antibody to CCR4**, classified in Class 424, subclass 143.1.

II. Claims 23-31 and 33-38, drawn to a method of blocking trafficking of systemic memory T cells by administering a CCR4 antagonist that is an **antibody to the CCR4 ligand TARC**, classified in Class 424, subclass 145.1.

III. Claims 23-25, 27-31 and 33-38, drawn to a method of blocking trafficking of systemic memory T cells by administering a CCR4 antagonist that is an **antibody to the CCR4 ligand MDC**, classified in Class 424, subclass 145.1.

IV. Claims 23-28 and 33-38, drawn to a method of blocking trafficking of systemic memory T cells by administering a CCR4 antagonist that is an **peptide or peptidomimetic**, classified in Class 514, subclass 2.

V. Claims 23-28 and 33-38, drawn to a method of blocking trafficking of systemic memory T cells by administering a CCR4 antagonist that is an **small organic molecule**, classified in Class 514, subclass 1.

VI. Claims 23-28 and 33-38, drawn to a method of blocking trafficking of systemic memory T cells by administering a CCR4 antagonist that is an **soluble T cell receptor**, classified in Class 424, subclass 184.1.

Art Unit: 1644

Claim 23 links inventions I, II, III, IV, V and VI. The restriction requirement among the linked inventions is subject to the nonallowance of the linking claim, claim 23. Upon the allowance of the linking claim, the restriction requirement as to the linked inventions shall be withdrawn and any claim depending from or otherwise including all the limitations of the allowable linking claim will be entitled to examination in the instant application. Applicants are advised that if any such claim depending from or including all the limitations of the allowable linking claim is presented in a continuation or divisional application, the claims of the continuation or divisional application may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. In re Ziegler, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

4. Groups I-VI are different methods. As noted supra, each method differs with respect to one or more of the ingredients administered and method steps; therefore, each method is patentably distinct.

5. These inventions are distinct for the reasons given above. In addition, they have acquired a separate status in the art as shown by different classification and/or recognized divergent subject matter. Further, even though in some cases the classification is shared, a different field of search would be required based upon the structurally distinct products administered and the various methods of use comprising distinct method steps which reach different endpoints. Therefore restriction for examination purposes as indicated is proper.

6. Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed.

7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jessica Roark whose telephone number is (703) 605-1209. The examiner can normally be reached Monday through Friday from 8:00 AM to 4:30 PM. A message may be left on the examiner's voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Chan can be reached on (703) 308-3973. Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 1600 receptionist whose telephone number is (703) 308-0196.

Papers related to this application may be submitted to Technology Center 1600 by facsimile transmission. Papers should be faxed to Technology Center 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM1 Fax Center telephone number is (703) 305-3014.

Jessica Roark, Ph.D.
Patent Examiner
Technology Center 1600
April 7, 2003

PHILLIP GAMBEL
PHILLIP GAMBEL, PH.D.
PRIMARY EXAMINER
TECH CENTER 1600
4/7/03